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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,675

09/26/2005

Valerie De la Poterie

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3249

22852

7590

05/27/2010

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

05/27/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/526,675	<b>Applicant(s)</b> DE LA POTERIE ET AL.	
	<b>Examiner</b> JYOTHSNA A. VENKAT	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 42-53 and 60-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-53 and 60-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/1/10</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

Receipt is acknowledged of amendment, IDS and remarks filed on 3/1/10.

#### **Status of claims**

**Claims 1-41 are cancelled.** Claims 88-119 are withdrawn from consideration as being drawn to non-elected invention (election with traverse dated 6/15/09). Claims 54-59 are withdrawn from consideration as being drawn to non-elected species (election with traverse dated 6/15/09).

Claims 42-53 and 60-87 are examined in the application. The elected species is carnauba wax drawn to “wax”.

In view of applicants' remarks, the 102 (b) rejection is hereby withdrawn.

#### ***Claim Rejections - 35 USC § 103***

Claims 42-53 and 60-73, 75-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over (U. S. Patent 6,264,933 or EP 1013256).

*EP 1, 013,256 is the European counterpart to US 6,264,933. EP 1, 013,256 and US 6,264,933 appear to have identical disclosures, for simplicity they will together be referred to hereinafter as “'933”. While any reference hereinafter to column and line numbers will be based upon the US patent disclosure, such reference should be interpreted as including the corresponding disclosure of the aforementioned EP counterpart*

#### ***Claim analysis***

Claim 1 recites the limitation “that the total volatile content is less than or equal to has a solids content of the composition”.

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Specification at page 4, penultimate paragraph defines, **the term "solids content" refers to the content of non- volatile matter"**.

Patent '933 discloses waxes, fillers, film forming polymers, thickeners, auxiliary film – forming polymers, and all these belong to “ solids content” and the addition of the weight percent of all these ingredients ( higher weight percent) **meet the limitations of claims 1-4.**

The weight percent of wax is 2-40 %; the weight percent of film forming polymer is 0.05-10%; the weight percent of filler is 0.5-10%; the weight percent of thickener is 0.5-10%; the weight percent of auxiliary film forming polymer is 0.5-15%; the weight percent of pulverulent compound is 0.01-30% (claims 43-45).

See col.6, ll 6-10 for weight percent of volatile oil which is 35-75 % (claims 45-47) and see col.5, line 59 through col.6, ll 11-19 (claims 48-51); see col.7, ll 10-30 (claims 52-53, 60-63) the wax weight percent is 2-40% ( claims 63-64) , see examples for *Vinyl acetate/allyl stearate* and see col.8, ll 14-20 for claims 65-71 see the weight percent of the film forming polymer at col.8, ll 43-45, which is 0.5 % to 15 % (claims 72-73) see col.4, ll 17-29 for water or water soluble solvent and the weight percent is 1-35 % (claims 75-78); see col.4, ll 5-10 for film forming polymer (claim 79); see col.9, line 15 for dyestuff (80 ); see col.5, ll 1-39 for filler (claim 81); and see col.9, ll 25-30 (claim 82); see col.6, line 19 through col.7, line 7 for non volatile oil (claim 83). Thus patent teaches all the limitations claimed and therefore the mascara compositions of patent would also have the claimed property claimed in claims 84-87

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions taught by patent '933 using wax, film former, non-aqueous phase, additional film former, volatile oil expecting the mascara compositions exhibit

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good curling as well as water proof taught by patent '933. This is a prima facie case of obviousness.

Claim 74 is rejected under 35 U.S.C. 103(a) as being unpatentable over (U. S. Patent 6,264,933 or EP 1013256) as applied to claims 42-53 and 60-73, 75-87 above, and further in view of U. S. Patent 5,959,009 ('009).

Patent '933 does not teach the limitation of claim 74. However patent '009 teaches mascara water proofing compositions using volatile oil and not using water. See example 1.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions taught by patent '933 using wax, film former, non-aqueous phase, additional film former, volatile oil and prepare compositions without water taught by patent '009 which uses volatile oil, film forming former expecting the mascara compositions exhibit good curling as well as water proof without using water taught by patent '009. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619